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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/066,506	01/31/2002	Case C. Grogan	003/243/SAP	5120

7590 03/16/2004

ATTN: MCMR-JA (Ms. Elizabeth Arwine- PATENT ATTY)
U. S. Army Medical Research and Materiel Command
504 Scott Street
Fort Detrick, MD 21702-5012

EXAMINER

PARK, HANKYEL

ART UNIT PAPER NUMBER

1648

DATE MAILED: 03/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/066,506	Applicant(s) GROGAN ET AL.	
	Examiner Hankyel T. Park	Art Unit 1648	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-48 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/15/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Examiner regrets for imposing a restriction requirement at this stage of the prosecution. Examiner finds it necessary for the requirement for the reasons stated below.
2. Examiner would like to suggest, at this time, a few minor amendments to the claims, in case Applicants' election of the invention includes the following claims:

Claim 20, insert -- and-- at the end of the Markush member (iii), and

Claims 32-34, change "A host cell" to "An isolated host cell."
3. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement is traversed (37 CFR 1.143).
4. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-11, 13, 15 and 17, drawn to a chimeric filovirus protein, classified in class 530, subclass 387.3.
 - II. Claims 12, 14, 16 and 18, drawn to a DNA fragment, classified in class 536, subclass 23.72.
 - III. Claims 19-28, drawn to a recombinant DNA construct, classified in class 435, subclass 172.3.
 - IV. Claim 29, drawn to self replicating RNA, classified in class 536, subclass 23.72.
 - V. Claim 30, drawn to infectious alphavirus particles, classified in class 536, subclass 23.4.

- VI. Claims 31 and 46, drawn to a pharmaceutical composition, classified in class 424, subclass 199.1.
- VII. Claims 32-34, drawn to a host cell transformed with a recombinant DNA construct, classified in class 935, subclass 66.
- VIII. Claims 35 and 36, drawn to a method for producing chimeric filovirus proteins, classified in class 435, subclass 42.
- IX. Claims 37-45, 47 and 48, drawn to a vaccine, classified in class 424, subclass 192.1.

5. The inventions are distinct, each from the other because: Inventions I-IX are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different modes of operation, functions and effects. Invention I is drawn to a chimeric protein, which can be used, for example, to induce immune response in a subject, while invention II is drawn to a DNA fragment, which can be used, for example, to encode a chimeric protein, while invention III is drawn to a recombinant DNA construct, which can be used, for example to transform a host cell, while invention IV is drawn to self replicating RNA, which can be used, for example, to produce infectious particles, while invention V is drawn to infectious particles, which can be used, for example, to produce more particles for protein studies, while invention VI is drawn to a pharmaceutical composition, which can be used, for example, to treat a subject, while invention VII is drawn to a transformed host cell, which can be used, for example, to

encode viral proteins, while invention VIII is drawn to a method for producing proteins, which can be used, for example, to induce immune response to the proteins made, and finally invention IX is drawn to a vaccine, which can be used, for example, to protect a subject from the viral infection.

6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

7. Because these inventions are distinct for the reasons given above and the search required for each group is not required for the other, restriction for examination purposes as indicated is proper.

8. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

9. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hankyel T. Park whose telephone number is 571-272-0907. The examiner can normally be reached on 6:00 a.m. -2:00 p.m. Mon-Fri.

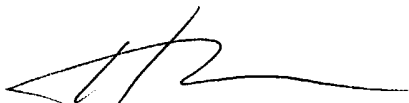
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel can be reached at 571-272-0902. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hankyel T. Park
Primary Examiner
Art Unit 1648



HANKYEL T. PARK, PH.D
PRIMARY EXAMINER